91-1898

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Supreme Court, U.S.
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No. 91-

IN THE

Supreme Court of the United States

OCTOBER TERM, 1991

VOIT SPORTS, INC.,

Petitioner,

vs.

ERIC W. REIMERS and
SUN MOUNTAIN SPORTS, INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI AND APPENDIX

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QUESTIONS PRESENTED

This case presents issues as to whether monopoly rights can be obtained in structures not covered by patents, and provides an opportunity for the Court to resolve the tensions between the Lanham Act and the Patent Statute, as well as the extent to which the coverage provided by patent claims defining the exclusive rights provided by a patent can be extended under a doctrine of equivalents. The lower trial and appellate courts appear to be granting exclusive protection to unpatented structures in contravention of the guidance provided by the Court in Sears, Roebuck & Co. v. Stiffel Co. (1964), infra; Compco Corp v. Day-Brite Lighting, Inc. (1964), infra; and most recently in Bonito Boats inc.,

v. Thunder Craft Boats Inc., (1989) infra.

1. If as asserted in Bonita Boats, infra, competition is essential to further the constitutionally mandated promotion and progress of the useful arts under the patent system, what degree of exclusivity can be provided to non-patented aspects of structures under concepts of trade dress and the doctrine of equivalents ?

(a) Is the purpose of the constitutionally based patent statute, which encourages competition by granting a limited monopoly to encourage the promotion and progress of the useful arts, undermined by expanding monopoly rights under concepts of trade dress and the doctrine of equivalents?

2. Can the appearance (as opposed

to the wrapping or labelling) of a product, which appearance would be the subject matter of design patent protection be protected as a trademark?

(a) Are the ornamental design features of a product such as would be covered by a design patent (as opposed to the packaging for the product) properly regarded as "trade dress" contemplated by the Lanham Act prohibition against the use of a "symbol or device" which would be false or misleading?

(b) If design aspects of a product are indeed properly regulatable under the Trademark Law, what is the balance to be provided between the the Trademark Law and the patent statute which will still promote creative activity?

(c) If the Lanham Act indeed

protects the appearance of a product, which would also be the proper subject of design patent protection, can the use of a producers trademark on the product, obviate the prohibited likelihood of confusion?

3. Is the public not entitled to rely on the definition of a patentee's invention as set forth in the claims of a patent?

(a) How far can the doctrine of equivalents extend to the protection provided by patent claims to give an inventor the benefit of his or her invention?

(b) Has the Court of Appeals properly applied the "function/way/result" criteria of Graver Tank & Mfg. Co. v. Linde, infra, in determining equivalence?

List of Parties

The caption of the case contains the names of all parties to the proceeding in the United States Court of Appeals for the Federal Circuit whose judgment is sought to be reviewed. There is no parent or subsidiary company of Voit Sports Inc., the petitioner, to be identified under Rule 29.1 of the Rules of the Supreme Court of the United States.

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No. 91-

IN THE

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OCTOBER TERM, 1991

VOIT SPORTS, INC.,

Petitioner

vs.

ERIC W. REIMERS and
SUN MOUNTAIN SPORTS, INC.,

Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner, Voit Sports, Inc., asks that a writ of certiorari issue to review the judgment entered by the United States Court of Appeals for the Federal Circuit, entered January 29, 1992, affirming without opinion the order of the Nevada District Court.

Opinions Below:

The Court of Appeals for the Federal Circuit, issued no opinion, merely issuing a JUDGMENT reproduced as Appendix A, in which it affirmed without opinion the ORDER GRANTING PRELIMINARY INJUNCTION AND SUMMARY JUDGMENT of the United States District Court for the District of Nevada, which also has not been reported, and is reproduced as Appendix B.

Jurisdiction

The judgment of the United States Court of Appeals for the Federal Circuit is dated January 29, 1992. That Court denied a timely petition for rehearing by an ORDER dated February 26, 1992, as reproduced in Appendix C. This petition is filed within 90 days of that date and therefore is timely.

The jurisdiction of this court is invoked pursuant to 28 U.S.C. §1254(1). The United States District Court for the District of the Nevada had jurisdiction pursuant to 15 U.S.C. §1121; 28 U.S.C. §1338, and under the doctrine of pendent jurisdiction. The Court of Appeals had jurisdiction pursuant to 28 U.S.C.§1291 and 15 U.S.C. §1121.

Constitutional Provisions and Statutes Involved

The United States Constitution, Article 1, § 8 provides in pertinent part:

> "The Congress shall have power... To promote the Progress of Science and useful Arts by securing for Limited Times to Authors and Inventors the exclusive Right to their respective Writings and

Discoveries."

Title 35, §101, United States Code provides:

"**Inventions Patentable**

Whoever invents and discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Title 35 § 171 United States Code provides:

"**Patents for Designs:**

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent, therefore, subject to the conditions and requirements

of this title..."

Title 15, §1125(a) United States Code as amended, effective November 16, 1989, §43(a) of the Lanham Act, provides as follows:

Unregistered Marks; False or Misleading Descriptions and Representations

"Any person who on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which-

(1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or

association of such person with another person, or as to the origins, sponsorship, or approval of his or her goods, services, or commercial activities by any other person, or

(2) in commercial advertising or promotion misrepresents the nature, characteristics qualities or geographic origin of his or her or another persons goods, services or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

Statement of the Case

Petitioner, Voit Sports Inc. (Voit) merchandises a variety of sporting

goods, including a line of some twenty different golf bags, among which are several which are tripod supported. Eric W. Reimers, and Sun Mountain Sports Inc. (collectively, Sun Mountain) are the respondents herein. Eric W. Reimers (Reimers) is the named patentee and owner of a patent covering a tripod supported golf bag charged to be infringed by one of the Voit bags. Sun Mountain Sports, Inc. is a licensee of Reimers. The action was initially commenced by Sun Mountain, against Voit, in the Nevada District Court charging patent infringement and unfair competition based on a violation of the Lanham act arising from the ostensible similarity in appearance between the Sun Mountain bag and the Voit bag. At the time of commencement of the action, Reimers had filed for a reissue patent seeking broader patent

claims. Voit, which had been importing the golf bag charged to infringe, pointed out to Sun Mountain the fact that the claims of the original Reimers patent did not cover the Voit bag, and even though there were differences in the appearance of the Voit and Sun Mountain bags, Voit agreed to make further changes to avoid any similarity of appearance.

The changes were unacceptable to Sun Mountain.

The complaint was thereafter amended to charge infringement of the reissue patent and reiterating the unfair competition claim based on a trade dress violation.

Voit responded by filing a motion for summary judgment based on what it believed to be its intervening rights under 35 U.S.C §252, arising from the fact that Voit had been selling

its bags before the Reimers patent had been reissued with claims covering the Voit bag; and asserting no trade dress violation in view of the fact that there were a variety of other bags sold under a variety of different names as similar in appearance to the Sun Mountain bag as the Voit bag, so that the requisite distinctiveness and/or secondary meaning were not present.

Sun Mountain cross moved for summary judgment or a preliminary injunction.

The Nevada District Court issued an order granting both summary judgment and a preliminary injunction in Sun Mountain's favor. The order found patent infringement under the doctrine of equivalents, finding that a full-length bag divider recited in the claims of the Reimers patent, and argued by

Reimers in the prosecution of his patent, to be distinguishable over the prior art, was the equivalent of a partial length divider employed by Voit. The Nevada Court further found a trade dress violation arising from the similarity of appearance between the Sun Mountain and Voit bags, apparently ignoring the evidence of the third party bags, having an appearance like that of the Sun Mountain bag.

The Court of Appeals for the Federal Circuit in its Judgment, affirmed without opinion the District Court order granting summary judgment, and a preliminary injunction.

Voit petitioned for rehearing, and suggested rehearing in banc. The Court of Appeals denied both petitions.

Reasons for Granting the Petition

I. THIS CASE RAISES IMPORTANT QUESTIONS REGARDING THE TENSIONS THAT HAVE ARISEN AND ARE BEING COMPOUNDED BETWEEN THE PATENT LAW AND THE TRADEMARK STATUTE, AND MORE PARTICULARLY THE APPLICATION OF §43a OF THE LANHAM ACT, WHICH HAS BEEN EMPLOYED TO PROVIDE PROTECTION FOR UNPATENTED STRUCTURES WHICH ARE CLEARLY MARKED AS TO THEIR SOURCE.

The issues raised in this case are companion to those presented in Two Pesos Inc.v. Taco Cabana International Inc., 91-971, now pending before the Court, and are submitted to provide an opportunity for the court to provide direction with respect to the protection to be provided to the unpatented appearance of a product in a competitive market.

The order of the District Court, as affirmed by the Court of Appeals,

without opinion, provides protection for the unpatented appearance of a structure, based on findings of secondary meaning. Notwithstanding the fact that the record before the district court and the Court of Appeals provided ample evidence of competing golf bags having a substantially identical appearance sold under a different trademark, and notwithstanding the fact that the bags were clearly labelled as to their source.

The case presents one of the more blatant examples of how the Lanham Act is being employed to sidestep the patent statute and provide protection on unpatented products contrary to the precepts set forth by the Court in its opinions in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, (1964); Compco Corp. v. Day-Brite Lighting Inc, 376 U.S. 234 (1964) and

Bonito Boats Inc. v. Thundercraft Boats, Inc., 489 U.S.141, 109 S.Ct.971, 103 L.Ed. 2d 118 (1989).

Sears and Bonito make clear that the States could still "protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings from misleading purchasers as to the source of the goods." Sears, supra at 232 as quoted in Bonito, 484 U.S. at 157 (emphasis added). Bonito quotes approvingly Judge Learned Hand's statement:

> The plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant on the other hand, may copy plaintiff's goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale.

It thus appears clear that the only rights properly protectable under the guise of trade dress are the rights of a given manufacturer to prevent others from selling their product as those of the manufacturer.

It further seems clear that where products are clearly labelled, there can be no confusion between such differently labelled products.

Section 43a of the Lanham Act expressly provides protection for "any word, term, name, symbol or device or any combination thereof" used "in connection with any goods or services, or any container for goods" "which is likely to cause confusion or cause mistake or to deceive..." (quotations rearranged for emphasis).

The Act does not refer to trade dress and the terms "symbol or device"as recited in the Act are being read

to encompass the appearance of an object under the rubric of "trade dress." This appears to be erroneous in that the shape of a useful article is not normally described as a "symbol, or device" and certainly such shape or appearance is not being used "on or in connection with any goods." This latter phrase "on or in connection with" is normally read to indicate that a separate entity is being applied to a base element. Thus this "symbol or device" which is a separate entity such as a label, tag or imprint is applied to goods. Different symbols or devices may be employed on identical goods, serving to distinguish the goods.

Further, § 43a prohibits the use of a "word, term, name, symbol or device" which is "likely to cause confusion, or to cause mistake, or to deceive---." It thus appears that

the Lanham Act indeed merely codifies the concepts expressed in Bonito, that the law may only protect unpatented products "to protect consumers from confusion as to source." (Emphasis in original).

Certiorari should be granted to provide clarification as to whether the language of the Lanham Act referring to "any word, term, name, symbol or device, or any combination thereof" can be regarded as embracing the appearance of an object, or whether this language merely refer at best to packaging, words and symbols which are separable from the goods or services.

Further, if the Lanham Act language indeed is intended to refer to the appearance of an object such as could be covered by a design patent, does the Lanham Act prohibit the use of

this appearance in the absence of a clear showing of likelihood of confusion. Can there be a likelihood of confusion if the products of the accused infringer are clearly labelled with trademarks identifying source?

II. THIS CASE PRESENTS AN OPPORTUNITY FOR THE COURT TO PROVIDE GUIDANCE TO THE APPEALS COURT AS TO THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS.

In Sontag Chainstores Co., Ltd v. The National Nut Company, 310 U.S.281, 298 (1940) the Court, quoting from the earlier case of Mahn v. Harwood, 12 U.S. 354 (1884) stated:

> The public is notified and informed by the most solemn act on the part of the patentee (the issuance of the patent) that his claim to invention is for such and such an element or combination, and for nothing more. Of course,

> what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee but was known and used before he made his invention. But, whether so or not, his known act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent.

In Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co, 339 U.S. 605 (1950) the Court stated that:

> courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection

> of the patent grant into a hollow and useless thing...
>
> The doctrine of equivalents evolved in response to this experience...
>
> A patentee may invoke this doctrine to proceed against the producer of a device if it performs substantially the same function in substantially the same way to obtain the same result....
>
> What constitutes equivalency must be determined against the context of the patent, the prior art and the particular circumstances of a case. Equivalence in the patent law is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect.

The Court of Appeals for the Federal Circuit appears to be in conflict as to how this doctrine of equivalents is to be applied.

In PennWalt Corp v. Durand-Wayland Inc, 833 F.2d 931, (Fed.Cir. 1987) (in banc), cert. denied 485 U.S. 961 (1988) the Court of Appeals for the Federal Circuit in an in banc opinion attempted to resolve the controversy

in its ranks with respect to the application of the doctrine of equivalents coming down with four opinions.

The majority, citing its earlier opinion in Perkin-Elmer Corp v. Westinghourse Elec. Corp, 822 F.2d 1528 (Fed. Cir. 1987) stated:

> One must start with the claim, and though a 'non-pioneer' invention may be entitled to some range of equivalents, a court may not, under the guise of applying the doctrine of equivalents, erase a plethora of méaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement...Though the doctrine of equivalents is designed to do equity and to relieve an inventor from a semantic straight jacket when equity requires, it is not designed to permit wholesale redrafting of a claim to cover non-equivalent devices, i.e. to permit a claim expansion that would encompass more than an insubstantial change....
>
> [I]n applying the doctrine of equivalents, each limitation must be viewed in the context of the entire claim...It is ...well settled that each element of a

> claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device. To be 'a substantial equivalent' the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed."

In a partial dissent joined by four of the Circuit judges, it was asserted that "The in banc majority... does not follow the precedents of this court," and goes on to note "the majority facially retains the historical test set forth in Graver Tank...but in practical effect the majority has eviscerated the underlying rationale of the Graver Tank test by requiring, under the doctrine of equivalents, an exact equivalent for each element of the claimed invention."

Further noting "To require a one-to one correspondence creates a bright

line rule, easier to apply, but costly to apply in terms of unfair results in exceptional cases. Such inequity has been rejected by the Supreme Court and up until today by our own precedents."

In a concurring view in Pennwalt, emphasis is given to an interpretation of 35 U.S.C.§112 pointing out that " a patent claim is not intended to be and cannot be only a general suggestion of an invention. The invention is defined by the limitations set out in the claim which thereby fix the scope of protection to which the patentee is entitled. The limitations in defining the invention tell the public what it cannot make, use, or sell. Equally important, the limitations defining the invention tell the public what it can make, use or sell without violating the

patentee's rights.

In another commentary by one of the judges in Pennwalt it has been asserted that :

"This court sitting in banc, has dealt a conspicuous change to a major jurisprudence in a patent case: in a judiciously created 'doctrine of equivalence'.

Notwithstanding the supposed clarification to be provided by this in banc Pennwalt decision, in Wilson Sporting Goods Co. v. David Geoffrey & Associates, 904 F.2d 676 (CA FC 1990) the Court of Appeals noted:

> This Court on occasion has characterized claims as being 'expanded' or 'broadened' under the doctrine of equivalents...
>
> To say that the doctrine of equivalents extends or enlarges the claims is a contradiction in terms. The claims - i.e. the scope of patent protection as defined by the claims...remain the same and application of the doctrine expands the right to exclude to 'equivalents'of what is claimed. (Emphasis in original)...
>
> The doctrine of equivalents, by definition, involves going beyond any permissible

> interpretation of the claim language; i.e., it involves determining whether the accused product is 'equivalent to what is described by the claim language.'

The Court then went on to say:

> ...to simplify analysis and bring the issue on familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product....If the hypothetical claim could have been allowed, the prior art is not a bar to infringement under the doctrine of equivalents."

Many have interpreted Wilson to mean that a patentee is entitled to encompass within the scope of his claim any subject matter to which a hypothetical claim could be drawn. That this is not the case and is violative of 35 U.S.C. § 112 appears clear. However, it raises a problem as to how to advise a client requesting advice on whether a given product to

be produced is covered by a particular patent. Even if the patent claims do not cover the product, there can be no way of knowing whether a hypothetical claim might be drafted by the patentee which would embrace the product.

The conflict in interpretations by the Court of Appeals for the Federal Circuit has recently been made manifest in Malta v. Schulmerich Carillions Inc. 952 Fed. 2d 1320 (Dec 26, 1991) where the Court of Appeals for the Federal Circuit, making no mention of the principles set forth in Wilson came up with a split decision in which two of the judges applied the "function/way/result" equivalency analysis of Graver Tank but went on to disagree about "how and why" the supposedly equivalent structure has the same "function/way/result." There

are two concurring opinions and one dissenting opinion.

In view of the great disparity of view among the members of the Court of Appeals for the Federal Circuit with respect to the application of the doctrine of equivalents, the results obtained by any given appellant are clearly dependent on the nature of the panel hearing the appeal.

In this particular case, Voit, the appellant was given short shrift with the panel affirming without opinion the ruling of the trial court which appeared to be incorrect.

Thus the trial court found equivalence between a golf bag defined in the claims of the patent as including "distinct, full length compartments" or having "a full length interior divider" (emphasis added). The patent on its face discloses that prior art

golf bags had partitions which do not extend the full length of the bag and asserted that this was a "disadvantage, in that the compartments formed by this type of device do not extend the length of the bag."

Further, in prosecuting the reissue patent, it was asserted that the divider aspect was present as a limitation in each of the claims" and that as a result of this limitation, the inventor had previously claimed less than that to which he was entitled."

The trial court in its decision, which was affirmed without opinion by the Court of Appeals, notwithstanding the above noted admissions of the patentee, and ignoring the function of the divider recited in the claims, namely to form "discrete" or "full length" compartments" held that since "plaintiff's divider is advertised

as "promoting easier club exit and entry" and "as keeping clubs untangled and allowing easy club entry and exit...the primary function of plaintiffs divider is that of facilitating a golfers access to clubs by keeping clubs within the golf bag separated into small groupings" and found that "there is no doubt that the primary function of defendant's divider is the same..." The trial court in the decision affirmed by the appellate court appears to have found function based on advertising claims by the patentee's licensee ignoring completely the functional statement in the claim.

This is not known to comport with any of the standards for applying the doctrine of equivalence articulated by the apparently split Court of Appeals for the Federal Circuit.

The case provides the Court with what is respectfully submitted to be an opportunity to clarify the proper application of the doctrine of equivalents.

Conclusion

The Court should grant the petition and review the order affirmed without opinion of the Court of Appeals for the Federal Circuit.

May 26, 1992

Respectfully submitted,

Robert W. Fiddler,
Counsel of Record

APPENDIX

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

91-1203, -1282

ERIC W. REIMERS, and
SUN MOUNTAIN SPORTS, INC.,

Plaintiffs-Appellees,

v.

VOIT SPORTS, INC.,

Defendant-Appellant

JUDGMENT

ON APPEAL from the United States District Court for the District of Nevada

in CASE NO(S). CV-N-90-015-BRT

This CAUSE having been considered, it is

ORDERED and ADJUDGED: AFFIRMED.
See Fed. Cir. R. 36

Per Curiam (NEWMAN, ARCHER, and PLAGER, Circuit Judges).

ENTERED BY ORDER OF THE COURT

DATED JAN 29 1992

s/s Francis X Gindhart
Francis X. Gindhart, Clerk

APPENDIX A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEVADA

CV-N-90-015-BRT

ERIC W. REIMERS, an individual and SUN MOUNTAIN SPORTS, INC., a Montana Corporation,
Plaintiffs,

v.

VOIT SPORTS, INC., a New York Corporation,
Defendant.
_____/

ORDER GRANTING PRELIMINARY INJUNCTION AND SUMMARY JUDGMENT

This case is before the court on plaintiffs' application for a preliminary injunction. Also before the court is defendant's motion for summary judgment and plaintiffs' motion for partial summary judgment. Plaintiffs are claiming patent infringement, trade dress infringement (violation of the Lanham Act) and unfair competition These claims are discussed separately below.

separately below.

The jurisdiction of this court is based on both original jurisdiction, conferred by 28 U.S.C. § 1338(a) and 15 U.S.C. § 1121 and diversity jurisdiction, conferred by 28 U.S.C. § 1332.

Plaintiffs are Eric W. Reimers, the inventor and owner of all patent rights to the Eclipse golf bag, and Sun Mountain Sports, Inc., a manufacturer of golf equipment, and a licensee under the patents.

Plaintiffs are claiming infringement by defendant, Voit Sports, Inc. of patent 4,685,561 (hereinafter '561), under 35 U.S.C. §§ 280 et seq. Plaintiffs state that defendant has had actual knowledge of its infringement since October 10, 1989. Plaintiffs are also claiming infringement of patent 33,203 (hereinafter '203) also under

35 U.S.C. §§ 280 et seq. Patent '561 was issued on August 11, 1987 and remained in effect until patent '203 was issued on April 24, 1990 (a reissue of '561). Claims 1 through 17 of the '203 patent are identical to those of the '561 patent. Claims 18 through 27 of the '203 patent were added by reissue.

Preliminary injunction

Patent infringement

In order to obtain a preliminary injunction, plaintiffs must demonstrate either a likelihood of success on the merits and the possibility of irreparable injury or, that serious questions of fact going to the merits exist and that a balancing of hardships would favor plaintiffs. Vision Sports, Inc. v. Melville Corp. 888 F.2d 609, 612 (9th Cir. 1989).

Defendants argue that patent infringement cannot lie as defendants' bag charged to infringe was not covered by the claims of patent '561 as originally granted and that defendant obtained intervening rights under 35 U.S.C. § 252 with respect to reissue patent '203.

To establish a likelihood of success on the merits in a patent case, the plaintiff must clearly establish the validity of the patent and that it has been infringed. Atlas Powder Co. v. Ireco Chemicals, 773 F.2d 1230, 1231 (Fed. Cir. 1985).

There is a statutory presumption of patent validity. 36 U.S.C. § 282. Thus in the absence of evidence to the contrary, the court is required to accept the validity of the patent Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d. 881, 885 (Fed. Cir. 1984).

Defendant here has not contested the validity of plaintiffs' patents.

Literal infringement has occurred if the accused device embodies every element of the patent claim. In Builders Concrete v. Bremerton Concrete Products, 757 F.2d 255 (Fed. Cir. 1985), defendant's marine float contained every feature but one of plaintiff's marine float claim. (In defendant's float the location of a utility passage and the opening for the passage differed from plaintiff's patent claim description). The court did not find literal infringement of plaintiff's claim.

Plaintiff's patent '561 describes the golf bag in part as follows:

> 1. ... [A]n interior divider adapted to separate the interior volume of the bag portion into a plurality of distinct, full length compartments...
> wherein the bag portion is characterized by having a longitudinal cross-section in

> the nature of a parallelogram, with said base and said collar forming lower and upper surfaces, respectively, which are parallel to a setting surface when the bag portion is in a rest mode...
>
> 9. ... [W]hen the base rests on a horizontal surface the top, while being parallel to the base, is not directly above the base but is horizontally offset therefrom such that the bag portion is situated at an angle of inclination of between 50(degrees) and 75(degrees) from horizontal; and
> means providing a full length interior divider to longitudinally divide the interior of the body portion into a plurality of discrete compartments.

Plaintiffs concede that claims 9-17 of '561 include a limitation to full length dividers but plaintiffs state that claims 1-8 do not contain this limitation as to length of divider. Despite plaintiffs' contention, it appears clear that the only reasonable interpretation regarding divider length given the description: "divider adapted to separate the interior of the interior

of the bag into a plurality of distinct, full-length compartments" is that the dividers run the full length of the bag. There is no other way that distinct, full length compartments" could be created. (Emphasis added).

As defendant's Grass Hopper bag contains a divider that does not run the full length of the bag, defendant's golf bag cannot be said to literally infringe any of plaintiffs' '561 patent claims.

However, even if literal infringement cannot be found, infringement by equivalence may exist. The classical standard test, as applied to the facts in Bremerton is "whether the utility passage of the [defendant's] float 'performs substantially the same function in substantially the same way to obtain the same result'". Bremerton at 258 quoting Graver Tank

Co. v. Linde Air Products Co., 339 U.S. 605,610, 760 S.Ct. 854 (1950). In Bremerton, plaintiff supported by affidavits and deposition testimony argued that plaintiff's float was not limited to any specific route for the utility passage and that the location of the outlet was immaterial. The district court granted defendant's motion for summary judgment and found that defendant's method of routing was known in the prior art and that the utility passage performed the same function to achieve the same result as plaintiff's routing method, but not in substantially the same way. As a result, the structures were not equivalent. The Court of Appeals agreed with plaintiff that plaintiff's argument for the existence of equivalence was a question of fact which was supported by plaintiff's evidence, but the

Appellate Court declined to decide whether summary judgment was properly granted on the ground of non-equivalence and affirmed the lower court's decision on the basis of file-wrapper or prosecution history estoppel. (File wrapper estoppel "[p]recludes a patentee from obtaining a claim construction that would resurrect subject matter surrendered during prosecution of his patent application... limits a patentee's reliance on the doctrine of equivalents..."Bremerton at 258 quoting Thomass & Betts Corp. v. Litton Systems,Inc, 720 F.2d 1572, 1579 (Fed. Cir. 1983.).

Applying the equivalence test for infringement to this case:

Plaintiff's divider is advertised as "promot[ing] easier club exit and entry" and as keep[ing] clubs untangled and allow[ing] easy club entry and

exit".

Thus, the primary function of plaintiff' divider is that of facilitating a golfer's access to clubs by keeping the clubs within the golf bag separated into small groupings.

There is no doubt that the primary function of defendant's divider is the same and no claims are made to the contrary.

The evidence of prior art indicates that several different devices have been designed in the past in an effort to bring order to the golf bag. Some of these golf club separating devices were separate pieces, designed to be inserted into the bottom or top of the bag. Others either added considerable weight to the bag or were too flimsy for their intended purpose. Plaintiff's separating device was the first made of a material that was both

light weight and durable and that was also constructed to be an integral part of the bag itself.

Both plaintiffs' Eclipse bag and defendant's Grass Hopper bag perform their function of club separation by means of a rigid collar, divided into four sections of similar size and shape. To the collars are attached dividers constructed of similar material which serve to further define the separate areas of the bag. The only observable difference between the two is the length of the dividers. This difference in length does not appear to affect the manner in which the divider apparatus functions, hence, defendant's divider can be said to function in substantially the same way as plaintiffs' divider.

The result achieved by these two dividers is also the same - both collars create four separate areas for clubs

and the two attached material pieces further divide the bags into three sections. Both would appear to facilitate the removal and replacement of clubs as well their organization into groups in precisely the same way.

Thus, as defendant's divider performs "substantially the same function in substantially the same way to obtain the same results" as plaintiffs' divider, plaintiffs have demonstrated a likelihood of success on the merits on their patent infringement claim.

As far as plaintiffs' '203 patent is concerned, defendant argues that it has acquired intervening rights and that as a result, defendant may continue to use that which is claimed in the reissue patent, but was not so claimed in the original patent. This argument obviously fails where,

as here, a defendant is found to have infringed the original patent.

In support of their application for preliminary injunction, plaintiffs state that the invasion of the rights of a patentee, by taking advantage of the patent owner's research and promotional activities and the resulting market diversion, constitutes sufficient irreparable injury. Plaintiffs claim lost profits in the past, due to infringement, in excess of $100,000 and state that such loss will continue unless defendant is enjoined

Defendants argue that the purpose of a preliminary injunction is to maintain the status quo and to protect the rights of the parties pending a determination of the merits. The status quo to be maintained is the state of affairs which existed immediately prior to the filing of the litigation. Litton

Systems, Inc. v. Sundstrand Corp., 750 F.2d 952 (Fed. Cir.1984). Defendant states that for the four to five months prior to litigation it was actively selling its Grass Hopper bag hence, any injunction would hardly be a reversion to the status quo. Defendant also argues that injunctive relief should be denied where the infringer is solvent and money would adequately compensate plaintiff. Smith International Inc. v. Hughes Tool Co., 718 F.2d 1573 (Fed. Cir. 1983). Finally, defendant states that an injunction requiring defendant to withdraw merchandise from its customers would work a greater hardship on defendant than on plaintiffs.

In a patent case, irreparable injury to the patent holder is presumed when the validity of the patent and continuing infringement of the patent

has been clearly established. Smith International at 1581. Furthermore, "authorizing the wrongdoer to continue the wrong, only not at an increased rate, is in no realistic sense maintaining the status quo." Atlas Powder Co., 773 F.2d 1230, 1231.

The potential hardship to defendant which an injunction could cause appears to be minimal. Defendant does not manufacture the Grass Hopper bag itself, rather, defendant imports the bag from a Taiwanese manufacturer. Defendant's income is by no means solely dependent on its future sales of this particular model of golf bag, for it advertises, and presumably sells, many other models of non-infringing golf bags. The possible future harm to plaintiffs, if an injunction were not issued, is more difficult, if not impossible to calculate. Plaintiffs state that they

had the largest share of the golf bag market in 1989 (25.3%) and that the Eclipse model accounted for the great majority of these sales. Plaintiffs also state that sales of the Eclipse model in 1990 have shown a marked decrease in the rate of gain in sales. (1987 - 9,421; 1988 - 22,556; 1989 - 40,946; 1990 - 47, 163. All of these figures are for a three month period, March through May). Whether this has been caused solely by defendant's activities or by other, unrelated factors or by a combination of events cannot be determined.

It should also be noted that defendant was notified by plaintiffs on October 10, 1989 of the existence of plaintiffs' '561 patent and its possible infringement by defendant. Defendant was notified shortly thereafter of the reissue patent.

Defendant, however, continued to import and market its Grass Hopper bag.

Even assuming that none of plaintiffs' sales difficulties can be attributed to the appearance of defendant's product in the market place, and there is no doubt that plaintiffs will continue to be injured by defendant's infringement of its patent rights. Defendant will, no doubt, suffer some hardships if enjoined, but in the absence of any substantiating figures, it cannot be said that defendant will suffer the greater harm.

Trade dress violation

Plaintiffs claim that they have adopted a distinctive design and trade dress for their Eclipse golf bag and have used such in commerce. Plaintiffs state that this design and trade dress have acquired secondary meaning

Plaintiffs further claim that

defendants' Grass Hopper bag copies the design and trade dress of plaintiffs' Eclipse golf bag with the result that the bags are in direct competition. Such copying by defendants has caused and will continue to cause public confusion, mistake or deception with the result that the public is likely to believe that the Grass Hopper bag is sponsored or approved by plaintiffs. Plaintiffs also claim that this copying of design and trade dress constitutes false designation of origin of defendants goods, false description of representations of defendants' goods, or involve words or other symbols tending to falsely describe or represent defendant's goods.

Finally, plaintiffs state, and defendant admits, that defendant has falsely advertised its Grass Hopper bag as having full length dividers.

Plaintiffs assert that all of the above constitute false designation of origin. False descriptions, false advertising and as such are violations of Lanham Act 43(a), 15 USC § 1125(a).

Defendant claims that the appearance of plaintiffs' golf bag is functional and is hence not entitled to protection. Defendant also asserts that plaintiffs' trade dress cannot have acquired the secondary meaning that is required to support the trade dress charge and, even if secondary meaning is found to exist, defendant's golf bag is clearly marked with defendant's trademarks "Voit" and "Grass Hopper" so that the two bags are not confusingly similar.

Finally, defendant claims that plaintiffs cannot have been damaged by defendant's error in the description of its Grass Hopper bag and that that

error has since been corrected.

A claim for trade dress infringement under the Lanham Act requires that plaintiffs show that its trade dress is protectable, has acquired secondary meaning, and its imitation creates a likelihood of consumer confusion. Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837,842 (9th Cir. 1987). A product feature which is functional, that is "essential to the product's use or [which] affects the cost or quality of the article", is not protectable. Fuddruckers at 842. However, individual elements which are functional and therefore normally unprotectable are protectable when the collection of elements taken together as a whole is not functional. Id. (In Fuddruckers, a restaurant claimed trade dress protection for items such as directors chairs, white

tile, and an open bakery. The court stated that while Fuddruckers could not preclude other restaurants from using those items, it could "prevent competitors from using the items in a way that, viewed as a whole, is likely to confuse consumers." Id. n.7, p.842). (Similarly, in Dallas Cowboys, Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2nd Cir. 1979), defendant was prohibited from distributing or exhibiting "Debbie does Dallas" a film which featured a uniform confusingly similar to that worn by plaintiffs. The court stated that "because an item [i.e. the uniform] is in part incidentally functional, it is [not] necessarily precluded from being designated as a trademark", especially where plaintiffs' trademark claim is "in the particular combination of colors and collocation of decorations

that distinguish plaintiff's uniform..." Id. at 203.) (Also, in Vision Sports, Inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989) plaintiff's clothing labels bore its logo and used the colors red, black and white. Defendant was enjoined, not from using those particular colors but from using those same "colors in a particular graphic display which may be confusingly similar to [plaintiff's] logo format..." Id. at 614.

Here, there is no doubt that many features of plaintiffs' golf bag are functionally dictated and are therefore not protectable. However, plaintiffs are seeking protection for the overall combination of the various features they have incorporated into their Eclipse golf bag, not for individual features which may or may not be functional. The particular combination

of features utilized by plaintiffs cannot be said to be functional and is therefore entitled to protection.

To show a violation under the Lanham Act, plaintiffs must also show that their trade dress has acquired a secondary meaning, that is, that "the purchasing public associates that configuration with a particular source." Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F.2d 512, 517 (9th Cir. 1989). Factors to be considered in determining whether secondary meaning exists include: whether actual purchasers associate the product with plaintiffs; the degree and manner of plaintiffs' advertising; the length and manner of plaintiffs' use of the trade dress; and whether plaintiffs' use of the claimed trade dress has been exclusive. Clamp at 517.

Plaintiffs have presented evidence

that they began marketing the Eclipse golf bag in July, 1986 and that when the Eclipse bag was introduced it had a distinctive appearance which set it apart from other golf bags. Since that time, until February 1989 when defendant began marketing its Grass Hopper bag, there were no similar appearing golf bags on the market. Plaintiffs have invested at least $300.000.00 in advertising and promoting the Eclipse, and their ads reflect a desire to emphasize the special features and the quality of their product. Plaintiffs have also presented evidence that actual purchasers associate the distinctive appearance of the Eclipse golf bag with plaintiffs. This evidence makes clear that a secondary meaning has been established.

Finally, to establish trade dress infringement plaintiffs must also

demonstrate that defendant's imitation of plaintiffs' trade dress creates a likelihood of consumer confusion. Such a probability exists when customers viewing either plaintiffs' product or defendant's product are likely to confuse the source of the product. Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F. 2d 512,517 (9th Cir. 1989). Factors to be considered in determining if such confusion is likely include: the strength of plaintiffs' mark; similarity of the two marks; evidence of actual consumer confusion; marketing channels used; the type of goods involved and the degree of care likely to be exercised by purchasers; and defendant's intent in selecting the mark. Id.

Here, plaintiffs have presented evidence of actual consumer confusion: "I have now been informed that not

all of the golf bags which I had once thought all came from the same source are, in fact, manufactured by Sun Mountain, Inc., but some of them are instead manufactured in Tawain (sic)." Such evidence of actual confusion is persuasive proof of the likelihood of future confusion. Fuddruckers, 826 F.2d 837,845 (9th Cir. 1987). The photographic evidence from advertising brochures, plaintiffs list of Eclipse features "copied by defendant" [1], as well as examination

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[1] Plaintiffs list the following as features which the defendant has copied: (1) Bottom angled in relation to sides; (2) Top angled in relation to sides; (3) Shoulder strap attaches at bottom at two points; (4) Rounded triangular cross section; (5) Distinctive arrangement of club dividers; (6) Club dividers extend substantially below the top; (7) Shoulder strap top attachment strap encircling the bag (8) Nylon tape covering material; (9) 3 color scheme with bag proper, pocket sides, and pocket(footnote continues on next page)

of the bags themselves, establishes the striking similarity of the two bags. The great similarity between these two bags as well as defendants own advertisement, which erroneously included "full-length dividers" as a feature, strongly suggests the possibility of deliberate copying of plaintiffs' product.

As the evidence presented supports a determination that consumer confusion is likely and that plaintiffs' trade dress is protectable and has acquired a secondary meaning, plaintiffs have demonstrated a likelihood of success on the merits on this claim.

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faces each being a different color; (10) Built in stand; (11) Stand opening mechanism above stand legs when open; (12) Leather patches at strap attachment points having a blunted triangular shape; (13) Cloth strip forming decorative spline down bag spine; (14) Distinctive pocket arrangement; (15) White piping on pockets.

Once a plaintiff demonstrates a likelihood of confusion in an action claiming trademark or unfair competition it is ordinarily presumed that plaintiff will suffer irreparable harm if injunctive relief is not granted. Vision Sports, Inc. v. Melville Corp., 888 F.2d 609. p. 612 n.3 (9th Cir. 1989). In Vision Sports, plaintiff asserted both trademark and trade dress infringement, and while the court did distinguish these two infringement claims in terms of scope there was no distinction drawn as to the presumption of harm once confusion was shown. Nor should there be a difference for once a likelihood of success on the merits has been demonstrated, the potential harm to plaintiff caused by any type of infringement - loss of control over its own reputation and loss of good

will are identical. See, Apple Computer, Inc. v. Formula International, Inc., 725 F.2d 521, 526 (9th Cir. 1984). Thus, as plaintiffs here have demonstrated a likelihood of success on the merits on their trade dress claim, irreparable harm, in the event that an injunction were not granted, would be presumed.

Unfair competition

Defendant asserts that there is no unfair competition, for as far as such a claim is based on a violation of patent rights, such a claim is preempted by federal law. Sears Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 240 (1964). Also, defendant's bag is only similar to plaintiffs' to the extent of similar functional features in which plaintiff does not have exclusive rights and defendant's bags are clearly marked with defendant's

trademarks. Finally, defendant's state that its Grass Hopper bag is not being sold in Nevada, nor has it ever been sold in Nevada.

Plaintiffs state that this claim is not an attempt to seek state law protection for functional or non-functional aspects of their product which federal law preempts rather, this claim is based on trade dress infringement and defendant's false advertising which has resulted in wrongful profits to defendants and lost profits to plaintiffs.

Defendant's primary argument in support of its motion for summary judgment on this claim is that plaintiffs' unfair competition claim is preempted by federal law. In the cases cited by defendant, the patents on the subject articles were found to be invalid and the Supreme Court

held that when an article is not protected by either patent or copyright that article is in the public domain and state unfair competition law may not forbid others from copying that article. See Sears Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1963), Compco Corp v. Day Brite Lighting, 376 U.S. 234 (1963). Here, plaintiffs' patents are valid and plaintiffs are not seeking the protection of state law in lieu of the appropriate federal law. Rather, plaintiffs are seeking the additional protection which state law affords:

> The protection accorded by the law of trademark and unfair competition is greater than that accorded by the law of patents because each is directed at a different purpose. The latter protects inventive activity which, after a term of years, is dedicated to the public domain. The former protects commercial activity which, in our society, is essentially private.

Truck Equipment Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1215 (8th Cir.

1976), cert denied 429 U.S. 861.

In addition, courts have recognized that the federal unfair competition law, § 43(a) of the Lanham Act was "never intended to embody the entire general common law of unfair competition." Anheuser-Bush v. Florists Ass'n of greater Cleveland, 603 F.Supp. 35, 39 (N.D. Ohio, E.D 1984)) citing La Societe Anonymedes Parfums Le Galion v. Jean Patou, Inc, 495 F.2d 1265, 1270 n.5 (2nd Cir. 1974). Thus, both federal and state unfair competition claims may be brought even though the elements for both causes of action may be essentially the same. See, e.g., Visa Int'l Serv. Ass'n v. Visa Hotel Group, Inc., 561 F.Supp. 984 (D.Nev. 1983), Int'l. Soc'y. for Krishna Conciousness of W. Pennsylvania, Inc. v. Stadium Auth. of City of Pittsburg, 479 F.Supp. 792 (W.D. Penn 1979).

Nevada does not statutorily prohibit trade dress infringement nor are there any Nevada cases which specifically discuss Nevada's common law of unfair competition as it pertains to trade dress infringement. N.R.S. §598.512(1) however, does provide that proceedings may be instituted by the attorney general where a person is found to have engaged in "Deceptive trade practice":

> A person engages in "deceptive trade practice" when in the course of his business or occupation he:
> 1. Knowingly passes off goods or services as those of another.
> 2. Knowingly makes a false representation as to the source, sponsorship, approval or certification of goods or services.
> 3. Knowingly makes a false representation as to affiliation, connection, association with or certification by another...

N.R.S. § 598.410

The deceptive trade practices listed in this chapter (N.R.S. 598.410 to 598.414) "are in addition to and

do not limit the types of unfair trade practices actionable at common law or defined as such in other statutes of this state." N.R.S. § 598.490(2).

Finally, N.R.S. § 600.420 et. seq. provides for a civil cause of action by the owner of a registered trademark against any person who infringes on that mark. The case law does make clear, however, that registration of a trademark is not determinative of protection, rather it is from prior use that the right to protection arises. A.L.M.N., Inc. v. Rosoff, 104 Nev. 274, 278 n.1, n.2, 757 P2d 1319 (1988).

In light of the obvious desire of the legislature to protect both the public from deceptive trade practices and the owners of trademarks (whether or not they are registered) from infringing acts, it is clear that

Nevada would recognize plaintiffs' common law unfair competition claim. It is also clear, that as the elements necessary to establish a common law unfair competition generally mirror the elements of a federal claim under the Lanham Act, where a plaintiff has established a likelihood of success on the merits on a federal claim, he will also have established such a likelihood of success on a state claim.

However, as previously stated, the obvious purposes behind state unfair competition laws are to protect citizens of the state from deceptive trade practices and to protect those who do business in the state from infringing practices. Defendant, in support of its motion for summary judgment, has provided evidence in the form of an affidavit that it has never manufactured or sold its Grass Hopper bag in the

state of Nevada. As a result, plaintiffs' state claim is premature and therefore dismissed.

Summary judgment motions

Patent claim

Although early decisions disfavored summary judgment in patent cases, that general rule does not apply "if ' [t]he prior art and the patent claims are, without expert aid, easily understandable by anyone of modest intelligence.'" Continuous Curve Contact Lenses v. Rynco Scientific, 680 F.2d 605 (9th Cir. 1982) quoting Vermont Structural Co. v. Tatko bros. Slate Col., 233 F.2d 9 (2nd Cir.) cert. denied, 352 U.S. 917 (1956). Thus, both plaintiffs and defendant correctly state that summary judgment is as appropriate in a patent case as in any other type of case when there are no genuine issues of material fact

and the moving party is entitled to judgment as a matter of law. D.M.I., Inc. v. Deer & Co., 755 F2d 1570,157(Fed.Cir. 1985). Here, defendant is not disputing the validity of plaintiffs' patents nor do the parties disagree as to the actual construction of the two golf bags. their differences center on (1) the interpretation to be given to plaintiffs' original patent claims and (2) whether defendant's divider performs substantially the same function, in the same manner, with the same results, as plaintiffs' dividers. (Equivalence test). The interpretation of a patent claim is an issue of law and is therefore appropriate for summary judgment. Id. at 1573. However, application of the doctrine of equivalence (to determine if infringement by equivalent structures

has occurred), is a question of fact and in certain instances summary judgment may not be appropriate. D.M.I., Inc. v. Deer & Co., 755 F2d 1570, 1575 (Fed. Cir. 1985), See Builders Concrete, Inc. v. Bremerton Concrete Products Co., 757 F.2d 255, 258 (Fed.Cir. 1985). Here however, no conflicting evidence has been presented, and the structure and mode of operation of the golf bag devices are such that they can readily be understood by the court without the need of expert technical explanation. Summary judgment for plaintiffs as to this claim is therefore appropriate.

Trade dress infringement claim

Plaintiffs state that summary judgment is also appropriate for this claim and as defendant has itself moved for summary judgment, it seems reasonable to assume that defendant

also believes that summary judgment is appropriate.

The issues that must be determined are: whether plaintiffs' trade dress is non-functional and hence protectable; whether the trade dress has acquired secondary meaning; and whether imitation of the trade dress creates a likelihood of consumer confusion. These are all questions of fact. Vision Sports, inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989). Plaintiffs have supported their motion for summary judgment with affidavits which support the protectability of plaintiffs' trade dress as well as affidavits attesting to the existence of both secondary meaning and consumer confusion. ([C]onsumers...frequently recognize only the appearance of the golf bag about which they have been informed. They frequently identify

the Sun Mountain product solely by its distinctive appearance.").

> When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial.
>
> Fed.R.Civ.P. 56(e)

As defendant has not produced any affidavits or depositions that controvert plaintiffs' evidence no genuine issue of material fact has been established and summary judgment for plaintiffs is appropriate.

Unfair competition claim

As stated earlier, defendant has not sold its Grass Hopper bag in the state of Nevada. Defendant does admit, however, to falsely advertising the bag in the past as having full length dividers. Thus, although plaintiffs

have stated a valid unfair competition claim, it is premature. Therefore, defendant's motion is denied and this claim is dismissed.

It should be noted that defendant has come out, in its latest catalog with a new bag, called the "Easy Walker". Plaintiffs state that this new bag "clearly utilizes a different trade dress than the Eclipse and Grasshopper bags." Yet, plaintiffs later state that "the matter relating to trade dress infringement are applicable to the new version of tbe (sic) Grasshopper bag as well as to the original version. The only apparent difference between the old version and the new version is the angle of the bottom surface. This will have very little, if any, effect on the likelihood of confusion since only close inspection reveals that this

feature is different." Plaintiffs state that as to the patent issue summary judgment as to this new version would be premature. However, as to plaintiffs' trade dress claim, plaintiffs state that summary judgment is appropriate as to both the Grass Hopper and defendant's new "Easy Walker" bag.

Not only is plaintiffs' position confusing, but little of the evidence presented pertains to the "Easy Walker" bag. Accordingly, the court can neither enjoin defendant or grant summary judgment as far as this new bag is concerned.

Accordingly,

IT HEREBY IS ORDERED:

1. That defendant and its agents, servants, employees, attorneys and other person in concert or participation therewith be enjoined from:

(a) Directly or indirectly making, using, selling or aiding in the making, using or selling of the existing Model 685 "Grass Hopper" golf bag which infringes upon plaintiffs' patent and trademark rights, or other products substantially similar thereto or that otherwise infringe plaintiffs' patent or trademark rights; and

(b) Engaging in any other acts of infringement of plaintiffs' patent or trademark rights, or any other act of patent or trademark infringement, false advertisement against plaintiffs.

2. That defendant be required to deliver up for destruction all of its existing golf bags which infringe upon plaintiffs' patent or trade dress rights.

3. That defendant file with the court and serve on plaintiffs within

thirty days a written report, under oath, setting forth in detail the manner and form in which it has complied with this ORDER.

4. That a status conference will be held at 9:30 a.m. on the 26th day of October, 1990 to discuss and schedule further proceedings.

DATED September 14, 1990.

/s/ Bruce R. Thompson

UNITED STATES DISTRICT JUDGE

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IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF NEVADA

Case No. CV-N-90015-BRT

ERIC W. REIMERS, an individual
and SUN MOUNTAIN SPORTS, INC.,
a Montana Corporation,
Plaintiffs,
v.

VOIT SPORTS, INC., a New
York Corporation,
Defendant
_____/

ORDER GRANTING PRELIMINARY INJUNCTION
AND SUMMARY JUDGMENT

This case was before the Court on December 17, 1990 on plaintiffs' request for clarification of the Court's order of September 14, 1990. Said order of September 14, 1990 is fully incorporated herein by

reference. This order merely commemorates the bench order of December 17,1990 and is effective as of that date.

The paragraph beginning at page 21, line 15 of the above identified order has been clarified by the following identifying nomenclature. The defendant's Grass Hopper golf bag with a parallelogram frame has been identified as the "old version" and plaintiff's exhibit 2. The defendant's Grass Hopper golf bag with the bottom perpendicular to the longitudinal axis has been identified as the "new version" and plaintiff's exhibit 3. The defendant had introduced a new version of its Grass Hopper bag which was indistinguishable in any way from its former bag of the same name except in the orientation of the bottom with respect to the top and longitudinal

axis. It being visually similar, it was intended to be encompassed by the earlier order with respect to infringement of plaintiffs' trade dress rights. This clarification is not meant to be limiting of the previous order, but expands its injunctive scope to encompass both the new version and the old version of the Model 685 Grass Hopper bag, products substantially similar thereto and products that otherwise infringe plaintiffs' patent, trademark and trade dress rights. As to trade dress, summary judgment is found to be appropriate to both the new version and the old version of defendant's model 685 Grass Hopper golf bags and products substantially similar thereto. Summary judgment as to patent infringement is appropriate to the old version, but is premature as to the new version.

Accordingly,

IT IS HEREBY ORDERED:

1. That defendant and its agents, servants, employee, attorneys and other persons in concert or participation therewith be enjoined from:

(a) Directly or indirectly making, using or selling, or aiding in the making, using or selling of all versions of the "Grass Hopper" golf bag which infringes upon plaintiffs' patent, trademark, and trade dress rights, or other products substantially similar thereto or that otherwise infringe plaintiffs' patent, trademark, or trade dress rights; and

(b) Engaging in any other acts of infringement of plaintiffs' patent, trademark, or trade dress rights, or any other act of patent, trademark or trade dress infringement, or false advertisement against

plaintiffs.

2. That defendant be required to deliver up for destruction all of its existing golf bags which infringe upon plaintiffs' patent or trade dress rights including but not limited to all versions of the Grass Hopper golf bag.

3. That Defendant file with the court and serve on plaintiffs within thirty days a written report, under oath, setting forth in detail the manner and form in which it has complied with this order.

4. That a status conference will be held at 9:30 a.m. on the _____ day of _____, 1990 to discuss and schedule further proceedings.

Dated this 21 day of December, 1990.

/s/Bruce R. Thompson

ORDER

Before NEWMAN, Circuit Judge, ARCHER, Circuit Judge, PLAGER, Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing in banc is under consideration.

The mandate will issue on March 4, 1992.

FOR THE COURT,

Dated: February 26, 1992
s/s Francis X. Gindhart pt
Francis X. Gindhart
Clerk

cc: ROBERT W. FIDDLER
MICHAEL J. HUGHES

REIMERS V VOIT SPORTS, 91-1203
(DCT - CV-N-90-15-BRT)

APPENDIX C

(2)

Supreme Court, U.S.
FILED
JUN 2 8 1992
OFFICE OF THE CLERK

No. 91-1898

In The

Supreme Court of the United States

October Term 1991

VOIT SPORTS, INC.,

Petitioner,

vs.

ERIC W. REIMERS, and SUN MOUNTAIN SPORTS, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

Petitioner has couched the purported Questions Presented in such terms as to predispose an answer in Petitioner's favor. Further, the statement of questions urged by the Petitioner presupposes totally erroneous factual situations and addresses issues and evidence not presented to the courts below. The questions stated are not based upon the record of the present action, but upon hypothetical facts and nonexistent procedural history. A nexus between Petitioner's statement of Questions Presented and the present case is very difficult to establish. However, in an effort to resolve the matter, Respondents restate the Questions Presented in a manner more in accordance with the circumstances of the case, as set forth below.

1. Does the case of *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.* (1989), preempt protection of nonpatented aspects of commercial products and totally preclude the concept of product configuration trademarks?

(a) To the extent that trade dress rights constitute a "monopoly", is such consistent with the constitutional purposes of the patent statutes?

2. Can the appearance of a physical object, which may or may not be subject to design patent protection, be protected under the Lanham Act as having achieved trademark status?

(a) Can visual aspects of a product configuration itself, including ornamental features, features which serve as one of a variety of ways to achieve a particular function, and combinations of features into an overall commercial impression, constitute protectable "trade dress" under the Lanham Act, to the extent that such can be protected from false and misleading imitation?

(b) To the extent, if any, that "trade dress" protection and the purposes of the patent system overlap and are in conflict, what is the balance to be established therebetween?

(c) Is the likelihood of confusion in the marketplace between a product with established trade dress and a subsequent imitation thereof obviated by prominent marking with the trademarks of the distributors of the subsequent imitation?

3. To what extent is an imitator of a patented item entitled to rely on its own interpretation of the literal language of the claims in attempting to avoid liability for infringement of a patent?

(a) To what extent can the Doctrine of Equivalents be utilized to give an inventor the benefit of an invention?

(b) Was the Doctrine of Equivalents properly applied in this case?

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No. 91-1898

In The

Supreme Court of the United States

October Term 1991

VOIT SPORTS, INC.,

Petitioner,

vs.

ERIC W. REIMERS and SUN MOUNTAIN SPORTS, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

Respondents Eric W. Reimers and Sun Mountain Sports, Inc. (collectively "Sun Mountain") respectfully request this Court to deny the writ of certiorari prayed for by the Petitioner Voit Sports, Inc. ("Voit").

OPINIONS BELOW

The Orders of the courts below are as set forth in the Appendix to the Petition. The Court of Appeals for the Federal Circuit did not file opinions either in affirming the judgment of the District Court or in denying the requests for rehearing and rehearing *en banc* submitted by Voit. None of the earlier proceedings in this matter have been the subject of published opinions.

STATEMENT OF JURISDICTION

The relevant jurisdictional provisions are set forth in the Petition, at pages 2 and 3. This opposition is timely filed under 18 U.S.C. § 2101 and Rule 15.2 of this Court.

STATUTORY PROVISIONS INVOLVED

The relevant statutory provisions are set forth in the Petition, at pages 3-6.

STATEMENT OF THE CASE

Sun Mountain introduced the Eclipse® model golf bag, a revolutionary design having a unique shape and a novel integral stand mechanism, to the golfing market in 1986. The product, despite primarily word-of-mouth promotion, was a phenomenal success and by 1990 was by far the best selling "stand" type golf bag in the United States market.

The Eclipse bag incorporates structures which were the subject of three United States Patents obtained by Eric W. Reimers, President of Sun Mountain. Two of these patents substantially deal with the stand mechanism and were not a part of the present action. The third patent relates to the shape of the bag structure and was the subject of a reissue proceeding, which initiated prior to the entry of Voit's accused product (the "Grass Hopper") into the marketplace. By the reissue procedure, additional claims were added to the patent, the additional claims having language identical to that of the two original independent claims except that wording relating to interior dividers was entirely removed.

During the reissue proceeding Sun Mountain became aware

that Voit had begun, or was intending to begin, importing a golf bag manufactured in Taiwan and distributing it as a part of Voit's product line. Sun Mountain advised Voit as to its claimed patent and trade dress rights, including disclosing the scope of claims which had already been allowed in the reissue proceedings. An initial District Court action was filed in the District of Nevada against Voit and the Taiwanese manufacturer of the accused bag. When the producer of the bag was beyond service of process, the reissue process was completed, and discussions of settlement proved nonviable, an amended complaint was filed. Rather than filing an answer, Voit moved for summary judgment. Sun Mountain cross filed for partial summary judgment and, after briefing, hearing, and submission of substantial evidence, the District Court granted the Order of September 14, 1990 which is set forth in the Appendix to the Petition.

It was not disputed that the Grass Hopper bags literally infringed the added claims of the reissue patent, nor was the validity of the patent challenged. The only patent issues raised went to infringement of the original claims by products of Voit which predated reissue.

Voit introduced a very slightly modified version of the Grass Hopper bag to the market during the briefing period for the summary judgment motions. Subsequent to the September 14, 1990 Order, Voit continued selling the "New Version", taking the position that the Order and Injunction did not apply thereto. Consequently, Sun Mountain moved for clarification and, subsequent to briefing and hearing, the Order of 21 December 1990, effective as of 17 December 1990, was entered to encompass the New Version. After denial of Voit's motions for rehearing, etc., the appeal to the Court of Appeals for the Federal Circuit was commenced and resulted in the *per curiam* affirmance without opinion and the summary denial of requests for rehearing.

Voit's first submission of examples and arguments based on bags similar in appearance to the Eclipse bag was in the final reply briefing to the District Court in December 1990, after which no evidentiary submissions from Sun Mountain were possible. The claim of similar bags involved some examples of bags which were obviously dissimilar to the products in question and two examples of bags produced by or under license from Sun Mountain. Contrary to Voit's position, there was no evidence of "third party bags, having an appearance like that of Sun Mountain" (Petition at page 10).

Voit presented its position that the appearance of its own trademarks prevented customer confusion. This was presumptively taken into account by the lower courts in the analysis relating to likelihood of confusion. The common practice of multiple brand names for a single type of product, under single sponsorship or licensing, may have also played a part in this analysis.

Voit's patent arguments in the lower courts and in its Petition have consistently been based upon the interpretation of the words "full length dividers" and "full length compartments" as being unitary terms constituting inseparable claim elements. Respondents argued throughout that, at most, the "dividers" and "compartments" constituted defined claim elements, and that the adjectival term "full length" could be satisfied by equivalents. Voit has also taken the position that out of context statements in the specification can be utilized to limit the "function" of a claim element for analysis purposes, notwithstanding the plain meaning and the actual situation. Voit's arguments failed in the lower courts, despite being given full consideration.

Respondents' position is that Voit adopted an initial interpretation of the claim language and the law of trade dress specifically for the purpose of permitting entry into the marketplace with an intentional imitation of the highly successful and very

widely known Sun Mountain Eclipse golf bag. Voit has stuck by its version of the facts, or even modified its version to one supporting its current theories, despite proof to the contrary, and continues to present positions totally at odds with the facts as considered by the District Court. Voit's factual allegations, as presented in its Petition, are selected for support of its arguments, and not because of any actual nexus with the facts of this case. In addressing the arguments of Petitioner, below, Sun Mountain will allude to a nonexclusive selection of misstatements of fact perpetrated by Voit in the Petition.

REASONS FOR DENYING THE WRIT

I.

THERE ARE NO TENSIONS BETWEEN PATENT AND TRADEMARK LAW IN THIS INSTANCE, BEYOND THOSE HISTORICALLY RECOGNIZED AND ADEQUATELY ADDRESSED BY LONGSTANDING PRINCIPLES OF LAW.

Voit paints a picture of a conflict between patent law and trade dress law in this matter. This is a new argument by Voit, not previously argued in the action. Further, as volumes of case law have established over the years, none such exists. The nature of the rights granted thereunder are so fundamentally different that no conflict exists.

a) Voit attempts to draw a parallel to the case of *Two Pesos Inc., v. Taco Cabana International, Inc.* 91-971. None exists. In the present case there was a clear finding of secondary meaning in the marketplace, in direct contrast to the *Two Pesos* situation.

b) Petitioner's arguments based on *Bonito Boats* are not only

untimely, being raised for the first time in the instant petition, but are also inapplicable. Trade dress principles do not grant a "monopoly" similar to that of a patent (or that granted by the "plug molding" statute of *Bonito Boats).* The rights in trade dress are transitory and dependent on marketplace perceptions. Product configuration trademark rights, or similar rights applied to packaging, are severely limited to those of producers and/or sponsors who actually establish the perception in the marketplace, and maintain the association in the minds of consumers such that the very appearance of the product connotes an association with a single source. This is far different from the type of monopoly granted by any type of patent. Most significantly, of course, the analysis of *Bonito Boats* turned primarily on the issues of Federal preemption, a non-issue in the present case, since the Lanham Act is a federal statute. The Court clearly recognized this in *Bonito Boats* by distinguishing the protection of Section 43(a) of the Lanham Act from the Florida statute at issue.

c) Much of the content of a product configuration trademark, or trade dress, is not subject to a design patent in the classical sense. Some of the aspects found to be copied in the present case, such as the white piping around the pockets and the cloth spline down the handle seam, fall into this category as being too difficult to depict in a design patent drawing so as to constitute protectable subject matter. Further, the requirement in design patent law that the protected aspect be purely nonfunctional has been interpreted to be much more limiting than the functionality limitation as applied to trade dress. Courts have limited design patent protection in this area especially by reference to the requirement of nonfunctionality of the differences between an overall design and the prior art, *see e.g., Kwik-Site Corporation v. Clear View Manufacturing Co.,* 758 F.2d 167 (6th Cir 1985), a restriction which is not applicable to trade dress considerations. Novelty is also a requirement for the patent protection which is not necessary for trademark. All of these differences are adequately

compensated for by the requirements of distinctiveness, secondary meaning and the like which are applicable to the trademark body of law, and not to the little used design patent law.

d) This is far from a case of an extension of a monopoly without benefit of patent. Voit's products copied far more than the product configuration, there was an obvious attempt to capture the appearance and marketplace goodwill as well. Voit did not simply spot a new idea and adopt it, as in the Sears and Compco cases. Voit waited until after the Sun Mountain golf bags had already been widely accepted in the marketplace and had built up substantial recognition and goodwill, and then Voit attempted to usurp that goodwill by copying not only the function, but the distinctive appearance features and combinations thereof.

e) Voit also takes the position that the use of its own trademarks precludes a finding of likelihood of confusion as to "source". Not only is this a poor example, since Voit in this case applied its trademarks to a product produced in Taiwan by a third party and not produced by Voit, itself, but it ignores a significant portion of the wording of the statute. As set forth in the Petition at pages 5-6, 15 U.S.C. § 1125(a) specifically includes, in addition to restrictions on confusion as to source ("origins"), a prohibition as to confusion as to *"sponsorship or approval of his or her goods"*. In an age where multiple brands are often produced or authorized by a single source, with licensing and franchising common, the public clearly expects to see a variety of trademarks appearing on goods, without a diminution of the perception as to a single source of "origins, sponsorship or approval". Accordingly, even if the relatively inconspicuous trademarks of Voit are given their full weight (improperly, since buyer attraction may occur before these are even visible) this does not overcome the likelihood of confusion created by the copying of the distinctive overall appearance of the goods to the well known Sun Mountain (and Sun Mountain licensed) products.

II.

NO SPECIAL GUIDANCE ON THE DOCTRINE OF EQUIVALENTS IS REQUIRED.

Petitioner would have the Court believe that the lower courts are in need of guidance with respect to application of the Doctrine of Equivalents and that the instant case presents an opportunity to provide such guidance. Respondents submit, to the contrary, that even if there is some question regarding the application of the doctrine, the question does not arise under the circumstances of this case. Furthermore, the Court of Appeals for the Federal Circuit, having exclusive appellate jurisdiction, is fully capable of resolving any disparities in application of the doctrine by its own panels.

a) Contrary to the position taken by Voit, the present case is exactly the sort of circumstance for which the Doctrine of Equivalents, as set forth in the case of *Graver Tank & Manufacturing Co. v. Linde Air Products, Inc.* (1950), was intended. The facts of the present case clearly established that Voit's supplier slavishly copied every element of the primary claims of the patent in suit, with a single exception. Even that was not a complete exception. Far from a good faith attempt to avoid the teachings of the patent by utilizing a different structure, the present case represents a clear attempt to achieve an equivalent structure by making a slight and insignificant modification in a single element. There can be no question that Voit's supplier simply tried to squeeze through a perceived "loophole" rather than making a legitimate attempt to avoid the patent.

b) Petitioner would have the Court believe that the lower courts ignored an entire element of the claims in applying the Doctrine of Equivalents in the present case. This is simply not true. Voit has consistently presented its position at all levels of the case, and has

had it soundly rejected in each instance. It really boils down to a question of semantics. Voit's position presumes that an "element" of a claim is not only the base noun, but also the attendant adjectives. The "elements" of the independent claims which Voit asserts to have avoided in good faith are "full length" "dividers" and "compartments" formed by dividers. It is unquestioned that the accused bags include "dividers" and "compartments" formed by dividers. The element, as it is understood by Respondents, and apparently by the lower courts, is the noun, and this was undisputedly present in the Voit bags. The only difference lies in the adjectival qualities of the elements. Respondents successfully argued that, for the purposes involved, the partial dividers employed by Voit's supplier were the equivalent, under *Graver Tank*, to the full length elements set forth in the literal language of the original claims.

c) Petitioner also seeks to limit a consideration of equivalent structures by restricting the "function" portion of the analysis to out of context wording in the specification. Not only does this ignore other statements in the specification which indicate additional functional aspects but fails to follow the basic principle that patent language is to be interpreted in accordance with the relevant art. In the present instance there is no question whatsoever that any golfer would immediately recognize that the interior dividers are intended to separate the clubs and to prevent entanglements, yet Voit seeks to characterize this clear purpose as "advertising" and to imply that it was improper for the District Court to consider this.

d) Petitioner further seeks to argue, at this stage, that the partial length dividers of its bags were not equivalent to the corresponding elements of the claimed invention. This omits mention of the fact that Voit itself publicly advertised the Grass Hopper bags as having "full length interior dividers" when, in fact, they did not. Especially in this light, the lower courts were fully justified in rejecting Voit's denials of equivalent structure.

e) Petitioner also asserts something which appears to be a transmogrified version of the Doctrine of File Wrapper Estoppel. Voit alleges that since Applicant Reimers cited prior art patent references which had partial length dividers in the patent specification, and distinguished them by pointing out some of the disadvantages of the specific structures, this acts to prevent the patent from being interpreted under the Doctrine of Equivalents to encompass anything with partial length dividers, regardless of the overlap in other aspects. Not only does this ignore the fact that the Applicant also referenced prior art patents having *full length* dividers as well, but totally misses the entire purpose of the file wrapper limitation. As was abundantly clear from the grant of the reissue patent in which the claims were granted with no reference whatsoever to dividers of any sort, be they full length or partial length, this was not an element which was in any way crucial to patentability. Nothing in the arguments presented to the Examiner indicated a reliance on a distinction based on the length of the dividers as being the patentable aspect of the invention. In fact, such could not have been the case since the prior art included several examples of the full length dividers. This was, as it developed, a secondary issue which was irrelevant to eventual patentability. Equitable considerations, such as are embodied in the principles set forth in *Graver Tank*, do not support a position which strangle patent protection by limitation to the isolated language of the specification.

CONCLUSION

Petitioner Voit's prayers for the grant of certiorari in this matter are unsupported by either the facts or the law. Voit has postulated facts different from those ruled upon by the lower courts and tailored those facts to support hypothetical conflicts in the legal structure. Voit's versions of the facts and arguments as to the law, to the extent that such are not presented for the first time in the Petition, were considered by the lower courts and unanimously rejected. Nothing in the present case rises to the level of requiring a ruling from this Court. For all of the above reasons, Sun Mountain respectfully requests that the Petition for Writ of Certiorari be denied.

Respectfully Submitted,

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